

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nicholas K. Eib, et al.) Group Art Unit: 1756
)
 Serial No.: 10/825,342) Examiner: Deborah Checko-Davis
)
 Filed: April 14, 2004) Atty. Docket No.: 03-1810
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 For: OPTIMIZED MIRROR DESIGN)
 FOR OPTICAL DIRECT WRITE)
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RESPONSE TO OFFICIAL ACTIONRestriction/Election Requirement

Hon. Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

This response is presented to the Office Action mailed April 5, 2006, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, i.e., method claims 1-10, 13-20.

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason, there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.